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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/885,577	06/20/2001	Alexander C. Loui	82359SLP	3972

7590 03/22/2006  
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EXAMINER

SHIBRU, HELEN

ART UNIT PAPER NUMBER

2621

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/885,577

Applicant(s)

LOUI ET AL.

Examiner

HELEN SHIBRU

Art Unit

2616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/11/2003</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendments, filed 11/21/2005, have been entered and made of record. Claims 1-39 are pending. In view of the Applicant's amendment to the specification, drawings and claims 3, 12, 20, 25, and 32, the objections to the specification, figure 2, and claims 3, 12, 20, 25, and 32 are hereby withdrawn.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-39 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 36-37 are rejected under 35 U.S.C. 101 because the claims are directed to a recording medium storing nonfunctional descriptive material.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g. Warmerdam, 33 F. 3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory) and merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEP 2106.IV.B.1.

### ***Claim Rejections - 35 USC § 102***

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5 and 7-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Kaplan (US PG PUB 2002/0180803 A1).

Claims 15-21 will be discussed first.

Regarding claim 15, Kaplan discloses a method of generating a multimedia enabled disc, comprising the steps of:

- (a) selecting multimedia material, the multimedia material comprised of at least one audio clip from an audio database, at least one digital still image from an image database, and at least one video clip from a video database (see paragraphs 0031, 0042, 0044-0045);
- (b) downloading the multimedia material (see paragraphs 0044 and 0050);
- (c) downsampling the multimedia material (see paragraph 0054, 0060-0061);
- (d) providing user annotated material (see paragraphs 0034, 0035, and figures 6 and 7);
- (e) generating a composite image of the multimedia material and user annotated material (see paragraphs 0040-0042 and 0045);
- (f) encoding the composite image to provide an MPEG file (see paragraph 0052);
- (g) encoding the digital still image to provide a digital image tile (see fig. 6 and paragraph 0049);

(h) creating a disc image comprising the MPEG file and the digital image file (see figures 6 and 7 and paragraph 0052); and

(i) creating the multimedia enabled disc comprised of the disc image (see paragraphs 0040 and 0044).

Regarding claim 16, Kaplan discloses the step of transcoding the at least one video clip prior to creating the multimedia image (see paragraphs 0044 and 0052).

Regarding claim 17, Kaplan discloses the multimedia enabled disc is a VCD compatible optical disc (see paragraphs 0048-0050).

Regarding claim 18, Kaplan discloses the multimedia enabled disc is a DVD compatible optical disc (see paragraphs 0048-0050).

Regarding claim 18, Kaplan discloses the multimedia enabled disc is a SVCD compatible optical disc (see paragraphs 0048-0050).

Regarding claim 20, Kaplan discloses selecting a software application (see fig. 3 and paragraphs 0027, 0040, and 0060); and

recording the software application on the recordable optical disc (see paragraphs 0048 and 0050).

Regarding claim 21, Kaplan discloses selecting a computer file structure (see figures 6 and 6A and paragraph 0060); and

recording the computer file structure on the recordable optical disc (see paragraphs 0048 and 0050).

Claim 22, 25, and 29 are rejected for the same reason as discussed in claim 15 above.

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Regarding claim 23, the limitations of claim 23 can be found in claim 15. Therefore claim 23 is analyzed and rejected for the same reason as discussed in claim 15 above.

Regarding claim 24, Kaplan discloses each of the plurality of digital images files is a JPEG file (see fig. 1 and 1A and paragraphs 0031-0034 and 0061).

Claims 26-28 are rejected for the same reason as discussed in claims 17-19 above.

Regarding claim 30, Kaplan discloses a recordable optical disc having recorded information thereon, the recorded information comprising:

at least one MPEG bitstream encoding a plurality of digital still images as a multimedia digital graphics album (see paragraphs 0032, 0037, 0043-0044, 0052 and 0061); and

a plurality of digital image files, each of the digital image files encoding one of the plurality of digital still images (see paragraphs 0052-0053).

Claim 31 is rejected for the same reason as discussed in claim 24 above.

Regarding claim 32, the limitation of claim 32 can be found in claim 15 above.

Claims 33-35 are rejected for the same reason as discussed in claims 17-19 above.

Claims 36-37 are rejected for the same reason as discussed in claims 20-21 respectively above.

Regarding claim <sup>38</sup>~~32~~, the limitation of claim ~~32~~ can be found in claims 15 and 24 above. Therefore claim 38 is analyzed and rejected for the same reason as discussed in claims 15 and 24.

Regarding claim <sup>39</sup>~~32~~, the limitation of claim ~~32~~ can be found in claims 15 and 20 above. Therefore claim 39 is analyzed and rejected for the same reason as discussed in claims 15 and 20.

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Regarding claims 1, 3-5, 7, and 14, the limitations of these claims can be found in claim 15 above.

Claim 2 is rejected for the same reason as discussed in claim 24 above.

Claim 8 is rejected for the same reason as discussed in claim 16 above.

Claims 9-11 are rejected for the same reason as discussed in claims 17-19 above.

Claims 12-13 are rejected for the same reason as discussed in claims 20-21 respectively above.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kaplan in view of Official Notice.

Regarding claim 6, although Kaplan does not specifically disclose the step of selecting a digital still image as a background image; and generating a composite image comprising a still image and the background image, Kaplan discloses the control button controls the image to be viewed. Official Notice is given that it is well known in the art to select digital still images as a background image, and generate a composite image. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kaplan by selecting a background image and generating a composite image from the digital still image in order to represent the subject.

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following prior arts disclose generating a composite image comprising still image and a background image.

Beaulier et al. (US Pat. No. 4,568,981).

Tzidon et al. (US Pat. No. 5,737,031).

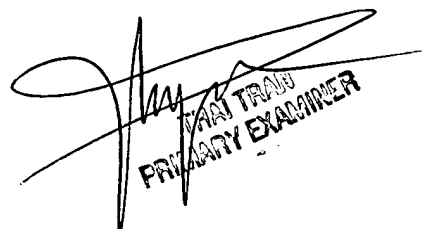
Iwamura et al. (US PG PUB 2001/0028463 A1).

Konuma et al. (US Pat. No. 6,771,319).

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to HELEN SHIBRU whose telephone number is (571) 272-7329. The examiner can normally be reached on M-F, 8:30AM-5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THAI Q. TRAN can be reached on (571) 272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



THAI Q. TRAN  
PRIMARY EXAMINER